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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,679	03/12/2001	Geoffrey B. Rhoads	P0329	1863

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DIGIMARC CORPORATION  
19801 SW 72ND AVENUE  
SUITE 250  
TUALATIN, OR 97062

EXAMINER

RAMAN, USHA

ART UNIT PAPER NUMBER

2611

DATE MAILED: 05/21/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

### Office Action Summary

**Application No.**

09/804,679

**Applicant(s)**

RHOADS, GEOFFREY B.

**Examiner**

Usha Raman

**Art Unit**

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3-22-04.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED OFFICE ACTION

### *Oath/Declaration*

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because applicant has not given a post office address anywhere in the application papers as required by 37 CFR 1.33(a), which was in effect at the time of filing of the oath or declaration. A statement over applicant's signature providing a complete post office address is required.

### *Drawings*

2. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Kenner et al (US Pat. 5,956,716).

In regards to claim 1, Kenner discloses a method for distributing video over the Internet. A content provides a web-page containing "video guide" that has the information user is interested in and informs the user of what subscription content is available (i.e. the subscribed-to video clips available to the user). A user sends a request for a content by selecting a link from the web page containing subscription content. Note column 23, lines 12-17 and lines 20-24. The system of Kenner therefore has the method of displaying to a consumer a listing of video titles (by informing the user what subscription content is available). A primary index manager (PIM) receives and processes user requests based on subscription privileges. Note column 24, lines 15-18. The system further comprises the method of receiving a signal indicative of the video title selected by the user (i.e. user clicks on a link to indicate the content he is interested in subscribing to, which is received by the primary index manager). Kenner discloses that billing records are updated for each request made by the user for a content that must be paid for each time it is viewed (i.e. pay per view) that a request is processed if the user has enough the charge limits (i.e. if the user does not have enough charge limits, the request for clip is denied). Note column 27, lines 28-30 and column 24, lines 47-50, 56-60. Therefore the system has the method of exchanging a fee. Upon proper authorization, the PIM initiates a DSI process to download the desired clip to the user's terminal. The DSI

receives the requested clip from the appropriate source, and adds data derived from the users ID by adding noise at various points along the stream, i.e. watermarks the video "on-the-fly" and transmits the clip to the requesting user. Note column 24, lines 14-23, column 25, lines 55-57, and lines 64-67. Kenner states that the watermarking authorities to track down copyright violators. Note column 26, lines 10-13. The system of Kenner therefore has the capability to watermark the requested video "on-the-fly" and transmit the video to the consumer.

In regards to claims 2 and 8, Kenner discloses watermarking the video with consumer ID. Note column 25, lines 64-67.

***Claim Rejections - 35 USC § 103***

5. Claims 3-4, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenner et al. (US Pat 5,956,716) in view of Moskowitz et al. (US Pat. 5,822,432).

In regards to claims 3, 4, 7 and 9, Kenner lacks the method of watermarking the video with more than one data from the list recited in claim 2 (i.e. a date identifier, an internet site from which the selected video and an identifier of an internet address to which the selected video is transmitted).

Moskowitz et al. discloses watermarking media contents with a plurality of data, including "metering" watermarks on content that identify the consumer, license agreement and terms and usage, watermarks containing other pertinent

information about the content, such as where to locate other copies of the purchased content or similar contents can be included in the content. An example of such information watermarked is watermarking the video content with one or more URLs. Note column 9, lines 29-40 in Moskowitz et al.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Kenner by watermarking the requested content with requester and/or distributor Internet address over the video content, as taught by Moskowitz et al. thus watermarking up to three data from the list recited in claim 2. The motivation is to provide additional information identifying the publisher location (the originating source), consumer location (the intended destination), and/or consumer ID (identifying the intended recipient) to track down copyright violators.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kenner et al. (US Pat. 5,956,716) in view of Fridrich (US Pat. 6,101,602).

In regards to claim 6, Kenner lacks the method of watermarking the video with an identifier of the date.

Fridrich discloses watermarking a media content with optional data such as a time and date identifier in addition to identifiers identifying the content itself. Note column 7, lines 5-8.

It would have been obvious to one of ordinary skill to modify the system of Kenner in view of Fridrich's teaching by watermarking a media content with a

date identifier. The motivation would be to provide means of identifying the date a purchase transaction was processed.

7. Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kenner et al. (US Pat 5,956,716) in view of Moskowitz et al. (US Pat. 5,822,432) as applied to claim 4 above, and further in view of Fridrich (US Pat. 6,101,602).

In regards to claim 5, as discussed above for claim 4, the modified system Kenner in view of Moskowitz has the method of watermarking the video with three data recited in the list. The modified system however lacks the method of watermarking the video with the fourth data from the list (namely identifier of the date).

Fridrich discloses watermarking a content with optional data such as a time and date identifier in addition to identifiers identifying the content itself. Note column 7, lines 5-8.

It would have been obvious to one of ordinary skill to further modify the system of Kenner in view of Moskowitz with Fridrich's teaching of watermarking a content with a date identifier. The motivation is to provide means of identifying the date a purchase transaction was processed and use that in conjunction with other watermark data to track down copyright violators.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usha Raman whose telephone number is (703) 305-0376. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

UR  
05-12-04



VIVEK SRIVASTAVA  
PRIMARY EXAMINER